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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,871	07/03/2001	Dean R. Shacklett	94-40187-US-D1-C	4121

7590 06/24/2003

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

69

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,871

Applicant(s)

SHACKLETT ET AL.

Examiner

Lawrence D Ferguson

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-- **Th MAILING DATE of this c mmunication appears on the c ver sheet with the correspondence address --**
P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Request for Reconsideration

1. This action is in response to the request for reconsideration, mailed April 14, 2003. Claims 1-21 are pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Instance (U.S. 4,933,043).
4. Instance discloses an adhesive label which has a base layer (18), an overlayer (30) and layers of folded information between the base layer and overlayer (see figure 3) while showing a tab feature (40) (see figure 7). Instance additionally discloses a label for affixing to a container comprising a series of panels with folded lines and a region extending beyond the edge (column 1, lines 25-43) and further comprising a backing of release material (column 2, line 55). Instance discloses a label made of paper (column 4, lines 52-54). The reference discloses the cover comprising a transparent plastic polymeric film (column 5, lines 30-39) covering part of the front surface of the label

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(column 5, lines 53-58). Instance discloses tabs and the panel detaching and re-attaching to the support web (column 6, lines 34-42). In claims 1 and 15, 'a label... suitable for being attached to a mounting surface' and 'suitable for coupling said base member to said mounting surface' adds no positive recitation to the claims. Additionally, in claims 1, 3, 9 and 15, 'at least one sheet forming said brochure' is a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Instance does not explicitly disclose the same tab features as claimed (figure 5), it would have been obvious to one of ordinary skill in the art to add tabs that project from the edge of the information layer(s) so that a reader can quickly flip to the relevant layer of information.

Response to Arguments

5. Rejection made under 35 USC 112, second paragraph are overcome due to Applicants' arguments. Rejection made under 35 U.S.C. 103(a) as being unpatentable over Instance (U.S. 4,933,043) have been considered but are unpersuasive. Applicant argues Instance fails to teach a brochure or overlying member that project beyond any edge of a base member, as depicted in Figures 1,2,3,4,6,7 and 10. Examiner

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respectfully disagrees because in Figure 3 of Instance, a support web (26) is overlapped by panels 10, 12 and 13. Additionally, if the panels are folded if Figure 1, layer 18 will be overlapped by panels 12 and 13. Applicant further argues the teachings of Instance are inconsistent with the recited limitation of claim 1. This is not true because Instance discloses an adhesive label which has a base layer (18), an overlayer (30) and layers of folded information between the base layer and overlayer (see figure 3) while showing a tab feature (40) (see figure 7), where Figure 3 of Instance, a support web (26) is overlapped by panels 10, 12 and 13. Additionally, if the panels are folded if Figure 1, layer 18 will be overlapped by panels 12 and 13. Applicant argues claims 2-14 should be patentable because they depend on claim 1. Because claim 1 was maintained, the rejection(s) made in regards to claims 2-14 and 15 are upheld for reasons of record. Applicant argues there is not a product by process limitation but rather at least one sheet forming the claimed brochure. Forming a brochure is a process limitation, therefore, the product by process rejection is maintained.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

